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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/050,979	01/18/2002	Lou Chauvin	83304DF-P	9113
7590 04/20/2007				
Milton S. Sales Patent Legal Staff Eastman Kodak Company 343 State Street Rochester, NY 14650-2201		EXAMINER LN, KENNY S		
		ART UNIT 2152		PAPER NUMBER
SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE		
3 MONTHS	04/20/2007	PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

10/050,979

Applicant(s)

CHAUVIN ET AL.

Examiner

Kenny Lin

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 05 February 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### DETAILED ACTION

1. Claims 1-21 are presented for examination.

#### *Claim Rejections - 35 USC § 101*

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claim 21 is rejected under 35 U.S.C. 101 because the invention is not limited to tangible embodiments (e.g., computer software program). As such, the claim is not limited to statutory subject matter and is therefore non-statutory. See MPEP § 2106.

A computer program having instruction is not tangible since such computer software program does not fall into the categories of “process”, “machine”, “manufacture” and “composition of matter”. Furthermore, the claim language of “such when loaded...” is not given patentable weight since the term “such” renders the claim indefinite. It is unclear whether the limitations following the phrase “such” are part of the claimed invention. Therefore, a computer software program *per se*, not stored by a computer storage readable medium, is non-statutory.

#### *Claim Rejections - 35 USC § 102*

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for

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patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-7, 9-17 and 19-21 are rejected under 35 U.S.C. 102(e) as being anticipated by Smart et al (Smart), US 2003/0208691.

6. Smart was cited in the previous office action.

7. As per claims 1 and 21, Smart teaches the invention as claimed including a method for providing custom offering for ordering of digital photo services over a communication network among a plurality of photo services providers from an order terminal, comprising:

- a. Maintaining information with respect to business relationships between said photo service providers and said plurality of business entities on a computer ([0116]; table 1, [0095-0101], [0170-0171], service description directory criteria relating to speed/cost/quality of work is the basis for establishing proper business relationship between the client and a printer shop service stored on server 1707, [0053]);
- b. Providing one or more digital images on a digital storage device ([0041]), said digital storage device being associated with one of said plurality of business entities ([0116]; table 1, [0095-0101], [0170-0171]);
- c. Receiving a request for goods and/or services at said computer over a communication network from said order terminal utilizing said digital images on

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said digital storage device ([0049], [0052-0054], [0063-0068], [0084], [0087-0089], [0116]); and

- d. Said computer providing a custom offering over said communication network for said goods and/or services on a display device at said order terminal based on said business relationship associated with said digital storage device ([0053-0054], [0063-0068], [0077-0078], [0116]; table 1; [0095-0101], the database directory displays different offering or quality of photos able to replicate at a particular service site, the client is able to select from such offering database directory to perform a photograph printout, the criteria in table 1 are options of services one may select; [0081-0082], [0088], offering for print services is displayed to the user, the printer service is identified as compatible or a 'match' to user's desire quality of print out; [0042], [0045-0047] users use the computer terminals to order printouts at a remote print shop service).

8. As per claim 10, Smart teaches the invention as claimed including a system for providing customer offerings for ordering of digital photo services over a communication network by a user among a plurality of photo service providers from an order terminal, comprising:

- a. A control system for maintaining information with respect to business relationships between photo service providers and a plurality of business entities ([0116]; table 1, [0095-0101], [0170-0171], criteria relating to speed/cost/quality of work is the basis for establishing proper business relationship between the client and a printer shop service), said control system having a communication

device for communicating with an order terminal over said communication network ([0044], network interface device inherently available on each of the network nodes) and receiving a request for goods and/or services from said order terminal with respect to digital images provided on a digital storage device, said digital storage device being associated with one of said plurality of business entities ([0049], [0053-0054], [0063-0068], [0084], [0087-0089], [0116]), said control system in response to said request providing a custom offering for said goods and/or service on a display device at said order terminal based on said business relationships associated with said digital storage device being associated with one of said plurality of business entities ([0053]; [0077-0078]; [0116]; table 1; [0095-0101], the database directory displays different offerings or quality of photos able to replicate at a particular service site, the client is able to select from such offering database directory to perform a photograph printout, the criteria in table 1 are options of services one may select; [0081-0082]; [0088], offering for print services is displayed to the user, the printer service is identified as compatible or a 'match' to user's desired quality of print out; [0042]; [0045-0047] users use the computer terminals to order printouts at a remote print shop service [0170-0171]).

9. As per claims 2 and 11, Smart teaches the invention as claimed in claims 1 and 10. Smart further teaches that the offering provides a subset of photo service providers from said plurality of photo service providers (Fig 14, item 508; [0077-0078]; [0116]; table 1; [0053], database

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directory orders the user to select from a plurality of photo printing services, examiner will interpret “subset” as “one or more” photo service providers).

10. As per claims 3 and 17, Smart teaches the invention as claimed in claims 1 and 10. Smart further teaches that said digital storage device includes a code which identifies the associated business entity (pg 8, table 1, I/O matching wherein the device attributes or codes are compared to obtain the optimum printing service; [0095-0101], physical location of the service).

11. As per claims 4 and 13, Smart teaches the invention as claimed in claims 1 and 10. Smart further teaches that said offering is displayed in a presentation format that is also based on said business relationship ([0081-0082]; [0088], offering for print services is displayed to the user, the printer service is identified as compatible or a ‘match’ to user’s desired quality of print out).

12. As per claims 5 and 14, Smart teaches the invention as claimed in claims 1 and 10. Smart further teaches that said order terminal comprises one of the following:

- a. An automated teller machine
- b. A photo kiosk
- c. A personal computer ([0042]; [0045-0047]; Fig2, item 102, 148)
- d. A wireless imaging device.

13. As per claims 6 and 15, Smart teaches the invention as claimed in claims 1 and 10. Smart further teaches that said digital storage device comprises one or more of the following:

- a. Optical disc;
- b. Magnetic floppy disc;
- c. Memory card;
- d. Digital camera (Fig 2, item 102).

14. As per claims 7 and 16, Smart teaches the invention as claimed in claims 1 and 10. Smart further teaches that said plurality of photo service providers provide one or more of the following services:

- a. Printing of digital images (Fig 2, where the digital images are printed out at remote printing services);
- b. On-line storage of digital images;
- c. Providing digital storage media containing digital images (Fig 2, item 102, camera inherently has memory to store digital images, further, user need to select camera images from camera's memory to perform print service);
- d. Providing associated goods and/or services with respect to hard copy prints (Fig 2, wherein the hard copy prints are supplied at remote printers, item 104 and 106).

15. As per claims 9 and 19, Smart teaches the invention as claimed in claims 1 and 10. Smart further teaches that said business relationships are maintained in a services directory by a service manager (pg3, [0053], service relationships or service descriptions/information necessary for establishment of such relationship is maintained within service directory; pg 10, [0127], wherein additional service is requested on behalf of the client by consulting its own record of available



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services, thus the business relationship between the services is maintained in a services directory on the network; [0078-0079], where relationships between different services are maintained in a directory listing in Fig 3).

16. As per claim 12, Smart teaches the invention as claimed in claims 1 and 10. Smart further teaches that said subset comprise two or more photo service providers (Fig 2, wherein the system comprises at least two printer vendors; Fig 14 and 15, item 508, the print shop service is an exemplary service, there are plurality of print shop services available over the network offering different quality of prints).

17. As per claim 20, Smart teaches the invention as claimed in claim 10. Smart further teaches that said digital storage device further includes application software for controlling said order terminal (pg 4, [0072-0075], wherein the software comprises of XML codes; [0042], where software is loaded into the computer from the computer readable medium, and then executed by the computer).

### ***Claim Rejections - 35 USC § 103***

18. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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19. Claims 8 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smart et al (Smart), US 2003/0208691, in view of Logan et al.(Logan), US 6,493,680.

20. Logan was cited in the previous office action.

21. As per claims 8 and 18, Smart teaches the invention substantially as claimed in claims 1 and 9. Smart further teaches said business relationships include friendly, neutral, and hostile relationships ([0170-0171]; [0175], an example as shown in Smart teaches user sending request to a remote print shop service to print out high photographs. Since applicant does not explicitly define business relationship in the specification, Examiner will interpret business relationship as relationship between two parties, i.e. requestor and service provider. Additionally, 'shop' has the meaning of "a mercantile establishment for the retail sale of goods or services", thus, the print shop service of Smart offers a business relationship between the requestor and the print shop service. The relationship is friendly because the print shop is providing a desired service to the user; the relationship is neutral because the relationship is based upon a service agreement between user and the service provider, i.e. the provider can offer print outs at a certain range of resolution). Smart does not explicitly teach hostile relationships. However, hostile relationship is well known in the art since a particular business agreement (e.g. instructions and steps to obtain services) while friendly to user A may at the same time being unfriendly to user B depending on the various types of skill level (e.g. computer usage skill, communication, understanding) of the users requesting for services. Logan teaches that a customer having a business relationship with services where the customer may become confused or hostile due to the complicated process of

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obtaining services (col.1, lines 50-67). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Smart and Logan and include hostile relationship as a possible type of business relationship in order to provide better services to satisfy hostile customers.

***Response to Arguments***

22. Applicant's arguments filed 2/5/2007 have been fully considered but they are not persuasive.

23. In the remark, applicant argued (1) Smart does not teach storage device as exemplified by a picture CD and memory card 195 in the specification. (2) No teaching or suggestion of maintaining business relationships, or the association with particular digital imaging media storage device with one of the business entities. Smart does not teach or suggestion maintaining information with respect to business relationships between photo service providers and a plurality of business entities. (3) Smart does not teach the providing of digital images in a storage media device wherein the storage media device is associated with one of a plurality of business entities and further providing offering to the displaying requesting such services based on said relationship associated with said digital storage device. (4) Smart reference does not teach or suggest the providing of custom offering based on prior established business relationship.

24. Examiner traverse the argument:

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As to point (1), in response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., picture CD and memory 195) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Furthermore, Smart's teaching of digital camera having image inherently functions as a digital image storage since digital camera are known to comprises build-in memories or expandable memory slots for inserting memory cards. Smart's paragraph 0049 further disclose the camera to store images in an internal memory.

As to points (2) and (3), Smart further disclosed a server 1707 for storing service description directory describing the information and types of services that the service providers and business entities connected among the network ([0053-0054], [0057-0068]). Furthermore, it is well known that the word 'shop' has the meaning of "a mercantile establishment for the retail sale of goods or services", thus, the print shop service of Smart offers a business relationship between the requestor and the print shop service for those requesting to print photos (see Smart's teaching of user sending request to a remote print shop to print out high resolution photographs in [0170-0171]; [0175]). Smart's teachings in [0170-0171]; [0175] hence clearly disclosed a business relationship associated with said digital storage device because services are provided by the print shop to the images in the digital camera [0049]. Smart disclosed a method to provide a custom offering for said services on a display device at said order terminal ([0053]; [0077-0078]; [0116]; table 1; [0095-0101], the database directory displays different offering or quality of photos able to replicate at a particular service site, the client is able to select from such offering database

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directory to perform a photograph printout; [0084], [0087-0089], the browser of the computer provides image retrieving and printing directing services for the user) based on said business relationship associated with said digital storage device (printing services performed based on the image stored in the digital camera, [0170-0171], [0175]).

As to point (4), in response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the business relationship is "prior established business relationship") are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

### ***Conclusion***

25. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

McIntyre, US 6,959,122.

26. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after

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the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

27. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kenny Lin whose telephone number is (571) 272-3968. The examiner can normally be reached on 8 AM to 5 PM Tue.-Fri. and every other Monday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bunjob Jaroenchonwanit can be reached on (571) 272-3913. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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April 17, 2007